

REMARKS/ARGUMENTS

The drawings are objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because they include reference signs 27 and 66, not mentioned in the specification. Accordingly, the specification has been amended to include reference numeral 27, and drawing Figure 3 has been amended to omit element 66.

Claims 1 and 8 have been amended to correct typographical errors.

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clegg et al. (U.S. Patent No. 5,477,459) in view of Wiklund (U.S. Patent No. 5,051,934). Specifically, the Examiner has rejected claims 1, 6, and 8 under the assertion that Clegg et al (hereinafter Clegg) discloses a method an apparatus comprising a portable display device that calculates positions of an object at different locations for determining whether a first down has been achieved from the location of a football on a field of play. Furthermore, the Examiner cites Wiklund for its teaching of the use of a distance measuring device and a reflector for reflecting light pulses from the device for determining the distance between a desired point and a reference location on a football field. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the method and apparatus of Wiklund into Clegg's system due to the fact that such a system would provide an alternate method and apparatus for determining whether a first down has been achieved, and further that such incorporation would have constituted an "alternative means/obvious engineering expedience" for one of ordinary skill in art.

The applicant respectfully asserts that a prima facie case of obviousness under 35 U.S.C. 103(a) has not been made in the rejection of claims 1, 6, and 8 for the following reasons. Initially, MPEP 2143.01 provides that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has expressly addressed the issue of whether a prima facie case of obviousness has been properly set forth. *In re Geiger*, 815 F.2d 686, 690, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) stated, in holding that the USPTO failed to establish a prima facie case of obviousness:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore hospital*, 73 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Based on the foregoing legal requirements to establish a prima facie case of obviousness, the applicants can find no teaching, suggestion or motivation in either Clegg or Wiklund to modify the disclosure of Clegg with the teachings of Wiklund to arrive at the claimed invention. In fact, the Clegg reference essentially teaches away from the invention as claimed by the applicants. For example, the Examiner states that Clegg discloses a portable display device at col. 15, lines 48-52. However, lines 48-52 of Clegg simply disclose a video display screen for displaying the relevant metes and bounds of a tract of land. Accordingly, Clegg simply does not disclose a portable display device having a micro-controller, associated memory, a transceiver, and an operator interface as required by claims 1, 6, and 8 of the instant application.

Furthermore, the Clegg reference requires the use of a sensing instrument 100 that must be positioned to sense radiation from at least three sources thereof in order to function properly. Additionally these radiation sources must be precisely located in relation to the area or tract being used, which precision placement must be accomplished by known in the art surveying methods. (See generally column 18, lines 29-61 of Clegg). The applicant's invention requires no external sources of radiation, nor does it require surveying to be undertaken in order to properly position these sources. Accordingly, Clegg actually teaches away from the applicants' invention as

claimed.

While Wiklund does in point of fact disclose the use of a distance measuring device and a reflector, it does not teach a distance measuring device capable of wireless communication with said portable display device as required by claims 1, 6 and 8 of the instant application.

Furthermore, applicant's claimed method of locating a football on a field of play to determine a first down is not taught or disclosed by either Clegg or Wiklund. While Clegg mentions that the apparatus disclosed therein may be used to locate a football on a field of play (col. 19, lines 17-23) no further details are given, and the method of the present invention is simply not disclosed by either reference cited.

Based on the foregoing, there is no teaching or suggestion to modify the Clegg patent with the teachings of Wiklund. Furthermore, Clegg simply does not disclose a portable display device having a micro-controller, associated memory, a transceiver, and an operator interface as required by claims 1, 6, and 8 of the instant application. Additionally, the applicants' method as claimed is simply not taught or disclosed by either reference. For all these reasons, a prima facie case of obviousness under 35 U.S.C. 103(a) can not be supported with respect to claims 1,6 and 8.

Since claims 2, 4, and 5 depend from claim 1, for the foregoing reasons a prima facie case of obviousness under 35 U.S.C. 103(a) can not be supported.

Furthermore, the Examiner has stated that, with respect to the rejection of claim 4, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit any data to a scoreboard or other display device for determining whether a first down has been achieved from the location of a football on a field of play. However, no reference has been cited in support of this assertion. For this additional reason, a prima facie case of obviousness under 35 U.S.C. 103(a) can not be supported with respect to claim 4.

Since claim 3 depends from claim 2, for the foregoing reasons a prima facie case of obviousness under 35 U.S.C. 103(a) can not be supported.

Since claim 7 depends from claim 6, for the foregoing reasons a prima facie case of

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obviousness under 35 U.S.C. 103(a) can not be supported. Furthermore, claim 7 is rejected as obvious under 35 U.S.C. 103(a) because heater and heater control circuits are known in the art for providing stable operation of outdoor electronic devices. However, no reference has been cited in support of this proposition. For this additional reason, a prima facie case of obviousness under 35 U.S.C. 103(a) can not be supported with respect to claim 7.

Based on the foregoing remarks the applicant hereby respectfully requests the removal of the Examiner's rejection of claims 1-8. Furthermore, passage of the present application to issue is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Alexander P. Brackett", written in a cursive style.

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Attachments